

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Thomas J. Kenney	Confirmation No.:	7260
Appl. No.:	10/597,862	Group Art Unit:	2617
Filed:	April 28, 2008	Examiner:	Barry W. Taylor
For:	SYSTEM AND METHOD FOR LIMITING MOBILE DEVICE FUNCTIONALITY		

Customer No.: 00826

FILED VIA USPTO E-FILING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This Reply Brief is filed in response to the Examiner's Answer mailed on April 28, 2011, the Examiner's Answer being in response to an Appeal Brief filed April 12, 2011. This Reply Brief addresses various points raised by the Examiner's Answer.

7. *Argument.*

As explained in the Appeal Brief on pages 5-10, Claims 1-3, 5-7, 9, 11-15, 17-20, 22-24, 26, and 28-31 are patentably distinct from the cited references, taken alone or in combination, and thus the combination of Muthuswamy and Kagay fails to render Claims 1-3, 5-7, 9, 11-15, 17-20, 22-24, 26, and 28-31 obvious. Further, as explained on page 10, Claims 4 and 16 are patentably distinct from the cited references, taken alone or in combination, and thus the combination of Muthuswamy, Kagay, and Adams fails to render Claims 4 and 16 obvious. Additionally, Claims 8, 21, and 25 are patentably distinct from the cited references, taken alone or in combination, and thus the combination of Muthuswamy, Kagay, and Hayatake fails to render Claims 8, 21, and 25 obvious. Accordingly, Appellant respectfully requests that the aforementioned rejections be reversed.

In reply to the Examiner's Answer, Appellant again submits that the cited references, taken alone or in combination, fail to teach or suggest the recited features of the claimed invention. The Examiner's Answer is, in large part, simply a restatement of the same rationale used in the final Office Action in rejecting the currently pending claims. As such, Appellant respectfully submits that since the Appeal Brief pointed out the flaws in the Examiner's reasoning with respect to these rejections, no further discussion of the issues previously

addressed need be presented herein. Rather, Appellant will direct the comments presented herein toward responding to the specific assertions from the “Response to Argument” section of the Examiner’s Answer (pages 18-21).

10. ***Response to Argument.***

The Examiner’s Answer identified several of Appellant’s arguments of section 7 of the Appeal Brief and provided responses to these arguments presented by the Appeal Brief. These arguments will be addressed below substantially in the order in which they were presented in the Examiner’s Answer for the sake of consistency.

A. Claims 1-3, 5-7, 9, 11-15, 17-20, 22-24, 26, and 28-31 are Patentable over Muthuswamy and Kagay

i. Independent Claims 1 and 24 are Patentable over Muthuswamy and Kagay

The Examiner begins the Response to Arguments Section on page 18 by reciting the claimed features of independent Claims 1 and 24 with added bolding and underlining as follows: “determine **a tracking function** to activate based **at least in part** on the **extracted information**, the tracking function being selected based **at least in part on one or more** of a time that has passed since the apparatus was lost or stolen **or** a location in which the apparatus was lost or stolen.” Next, the Examiner continues with a number of cites to Appellant’s specification, somehow concluding that “the selection of the method is nothing more than design choice.” Moreover, the Examiner continues, arguing that “the independent claims do not require all the limitations since ‘at least in part on one or more’ only require disabling a lost phone upon a user’s request, then maybe...make the phone ring,” which the Examiner argues is taught by the combination of Muthuswamy and Kagay, as recounted in the final Office Action. *See* page 20 of the Examiner’s Answer. Appellant’s note that the Examiner, in the final Office Action (and the Examiner’s Answer), in relevant part, cites Kagay as teaching a security module that “may also enable an alert sequence (i.e., tracking function) to assist in locating the mobile device if the owner is in a local area (i.e. or a location in which the apparatus was lost or stolen).” *See* page 6 of the Examiner’s Answer.

Appellant continues to disagree with the Examiner and note that the combination of Muthuswamy and Kagay fails to teach or suggest each and every feature in Claims 1 and 24. Evidence of this is present in the fact that the Examiner clearly *ignores* features present in these claims. In particular, the Examiner seems to bold/underline only certain language while ignoring other language. As such, Appellant now highlights the language in which the Examiner is clearly ignoring: “**determine a tracking function to activate** based at least in part on the extracted information, the tracking function being **selected based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen.**”

Appellant contends that neither Muthuswamy nor Kagay disclose determining or selecting a tracking function based on any criteria at all. Further, assuming *in arguendo* that Kagay discloses that which Examiner is alleging, which Appellants do not admit, the alleged disclosure still does not teach or suggest *selection* of a tracking function “based at least in part on one or more of a time that passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen.” At most, Kagay discloses the design option of activating an audible alarm for a lost phone. Mere activation of an alert sequence does not teach or suggest determining a tracking function to activate, let alone *specific selection* of a tracking function (e.g., what kind of tracking function, such a homing beacon, audio alarm, GPS positioning, etc, to use) based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen, as recited by Claims 1 and 24. In other words, Kagay nowhere teaches or suggests selecting a tracking function based on any criteria, let alone the specific criteria detailed in Claims 1 and 24. Appellant further contends that Muthuswamy, Adams, and Hayatake also fail to teach or suggest such a feature, and note that they are not cited as such. Thus, Appellant contends that the cited references, taken alone or in combination, fail to teach or suggest each and every feature of independent Claims 1 and 24.

ii. The Rejection of Claim 15 Should Be Reversed for Failure by the Examiner to Establish a *prima facie* Rejection

The Examiner, on page 21, argues “that Claim 15 is just as broad as Claim 1,” and concludes that the Examiner’s argument with respect to Claim 1 applies fully for Claim 15.

Appellant's believe the Examiner has missed some of the claim language present in Claim 15 which clearly distinguishes the scope of protection of Claim 15 with respect to Claim 1. In particular, Claim 15 recites, *inter alia*, "causing a disable signal to be broadcast to the mobile device." Clearly such a feature is not presently recited in Claim 1. Moreover, the method recited in Claim 15 may not necessarily be able to be performed by the apparatus of Claim 1. In other words, while the method of Claim 15 may, in some embodiments, be used to generate and broadcast a request that may be received by the apparatus of Claim 1, it does not follow that the apparatus of Claim 1 would perform the method claimed in Claim 15. As such, Claim 15 recites features which have not been addressed in the rejection of Claim 1.

Accordingly, the Examiner has failed to even allege with particularity that each feature recited in Claim 15 is taught or suggested by the cited references. It will thus be appreciated that the Examiner has failed to establish a *prima facie* case of anticipation or obviousness of Claim 15. This failure by the Examiner amounts to clear error and the rejection of Claim 15 should be reversed on grounds of this clear error.

iii. Independent Claims 15 and 28 are Patentable over Muthuswamy and Kagay

The Examiner, on page 21, does not specifically address Appellant's arguments with respect to Claims 15 and 28 and relies on the same arguments presented for independent Claims 1 and 24. As such, Appellant's also point to at least those reasons presented above with respect to independent Claims 1 and 24 and note that the same distinguishing features noted above are also present in independent Claims 15 and 28. As such, Appellant therefore respectfully submits that Claims 15 and 28 are patentably distinct from the cited references, taken alone or in combination, such that the rejection of Claims 15 and 28 should be reversed.

iv. Dependent Claims 2-3, 5-7, 9, 11-14, 17-20, 22-23, 26, and 29-31 are Patentable over Muthuswamy and Kagay

Because each of the dependent Claims 2-3, 5-7, 9, 11-14, 17-20, 22-23, 26, and 29-31 includes each of the recitations of a respective one of independent base claims 1, 15, 24, or 28,

In re: Kenney
Appl. No.: 10/597,862
Filing Date: April 28, 2008
Page 5

Appellant further submits that the rejection of the dependent claims should be reversed for at least those reasons set forth above.

CONCLUSION

For at least the foregoing reasons, as well as those presented in the Appeal Brief, Appellant respectfully requests that the rejections be reversed.

Respectfully submitted,



Charles A. Leyes
Registration No. 61,317

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON June 28, 2011.

LEGAL02/32713102v1